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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,010	04/18/2007	Myriam Bouet-Griffon	22130-00051-US1	6015

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Baker Donelson Bearman Caldwell & Berkowitz PC
Att: Docketing Sixth Floor
555 11th Street N.W.
Washington, DC 20004

EXAMINER

LEE, REBECCA Y

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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08/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,010	Applicant(s) BOUET-GRIFFON ET AL.	
	Examiner REBECCA LEE	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/16/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5-11 do not specify the composition is in wt or vol%. Therefore, the claimed Al alloy is considered vague and indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evancho et al. (US4082578).

Regarding claims 1, 5, 7-14 and 18-20, Evancho et al. disclose an aluminum alloy with a composition relative to that of the instant invention, in weight percent, as shown in the table below (Column 5, lines 60-68 and Column 6, line 1):

Element	Evancho et al.	Claims 1, 11 and 14	overlap	Claims 5, 7-10 and 18	overlap
Si	0.4-1.2	0.7-1.3	0.7-1.2	0.7-1	0.7-1

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Fe	0.05-0.35	0-0.5	0.05-0.35		
Cu	0.10-0.6	0.5-1.1	0.5-0.6		
Mn	0.2-0.8	0.4-1.0	0.4-0.8	0.45-0.6	0.45-0.6
Mg	0.4-1.1	0.6-1.2	0.6-1.1	0.6-0.9	0.6-0.9
Zn	0-0.2	0-0.7	0-0.2	0.15-0.3	0.15-0.2
Cr	0	0-0.25	0		
Zr+Ti	0-0.10	0-0.20	0-0.10		
Other elements	<0.05 each <0.15 total	<0.05 each <0.15 total	<0.05 each <0.15 total		
Al	balance	balance	balance		

Evancho et al. teach the aluminum alloy is used as a car body skin component (Column 1, lines 5-46), which attached to a steel component; but do not explicitly teach the body component is a body roof. However, Evancho et al. disclose the use of the component as motor vehicle body skin in general (Column 1, lines 6-9), without excluding any portion of the motor vehicle body. Thus, one of ordinary skill in the art would have appreciated any possible application of the aluminum alloy as taught by Evancho et al., such as a body roof as claimed.

Furthermore, Evancho et al. disclose the aluminum alloy exhibits a yield strength of 23-30 ksi (159-207 MPa) after solution treatment, quenching and aging (Column 6, lines 39-48). In addition, it is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. in this case, Evancho et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls

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upon the applicant to show that the process steps of Evancho et al. result in a materially different Al alloy product.

With respect to claim 14, Evancho et al. further teach the aluminum sheet can be 0.04 inch (1.0 mm) thick (Column 14, lines 58-60).

Regarding claims 2-4 and 15-17, Evancho et al. disclose the yield strength of the aluminum alloy is 25.9 ksi (178.6 MPa) before the paint baking and 47.0 ksi (324 MPa) after the paint baking (example 7, sheet B, Table V).

Regarding claim 6, Evancho et al. do not expressly teach the claimed range of Cu. However, it is well held that discovering an optimum value of a result-effective variable requires only routine skill in the art MPEP 2144.05. In the instant case, the amount of copper present in the aluminum alloy is a result effective variable since Evancho et al. teach the addition of copper can increase the strength level of the final product (Column 7, lines 22-44). Therefore, it would have been obvious to one of ordinary skill in the art to have optimized the amount of Cu present in the aluminum alloy of Evancho et al. in order to achieve a desired product.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REBECCA LEE whose telephone number is (571)270-

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5856. The examiner can normally be reached on Monday-Friday 8:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROY KING can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./
Examiner, Art Unit 1793

/Roy King/
Supervisory Patent Examiner, Art
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